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HENRY BRENDZEL
PO BOX 574
SPRINGFIELD NJ 07081

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OFFICE OF PETITIONS

In re Application of
Golestani :
Application No. 09/327,347 :
Filing Date: 5 June, 1999 :
Attorney Docket No. Golestani3 :

This is a decision on the petition filed on 6 May, 2003, alleging, *inter alia*, unintentional delay under 37 C.F.R. §1.137(b).

The Office regrets the delay in addressing this matter.

For the reasons set forth below, the petition as considered under 37 C.F.R. §1.137(b) is **GRANTED**, and the fee is charged as authorized to Deposit Account 50-0732.

BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the final Office action mailed on 6 June, 2002, with reply due absent extension of time on or before Friday, 6 September, 2002;
- the Examiner contacted Petitioner and a telephone interview was held on 7 January, 2003 (Summary mailed 8 January, 2003);
- the Office mailed a Notice of Abandonment on 4 March, 2003;
- Petitioner's requests of 26 February, 2003, and 6 May, 2003, to withdraw the holding of

abandonment were denied by the Group Director on 1 April, 2003, and 6 October, 2003, respectively, because: (a) the evidence in support of a showing that the Office received the reply (that Petitioner contended was timely filed) was unclear and insufficient; and (b) the reply, even if timely filed and received by the Office, was not a proper reply to a final Office action;¹

- because Petitioner made no further showing that the abandonment was due to unavoidable delay, in his reply to the 6 June, 2002, final Office action, the petition under 37 C.F.R. §1.137(a) was dismissed;
- Petitioner has filed a petition (with fee) under 37 C.F.R. §1.137(b), a reply, and—although he has not expressly made the statement of unintentional delay under the regulation—the instant petition is read and considered to state that the entire delay from the due date of the reply to the filing of a grantable petition was unintentional **and Petitioner must notify the Office immediately if this is not correct.**

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).²

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.³

Delays in responding properly raise the question whether delays are unavoidable.⁴ Where there is

¹ A proper reply is an amendment *prima facie* placing the application in condition for allowance, a Notice of Appeal, or a CPA or RCE (with fee and submission). (See: MPEP §711.03(c).)

² 35 U.S.C. §133 provides:
35 U.S.C. §133 Time for prosecuting application.
Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

³ Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

⁴ See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁵ And the Petitioner must be diligent in attending to the matter.⁶ Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁷))

The requirements for a grantable petition under 37 C.F.R. §1.137(b) are the petition and fee, a showing of unintentional delay, a proper reply, and a terminal disclaimer where appropriate. Here the terminal disclaimer is unnecessary. Petitioner has filed the petition, fee and reply, his statement has been interpreted to satisfy the regulatory requirements.

CONCLUSION

The instant petition under 37 C.F.R. §1.137(b) hereby must be and is **granted**.

The file is The instant application is forwarded to Technology Center 2100 to await the filing of the Appeal Brief and fee by Petitioners, pursuant to the regulations at 37 C.F.R. §1.192.

Petitioner has two months from the mail date of this decision to file the Appeal Brief in triplicate and fee. Extensions of time are governed by the regulations at 37 C.F.R. §1.136.

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.



John J. Gillon, Jr.
Senior Attorney
Office of Petitions

⁵ See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

⁶ See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

⁷ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.